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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR     | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/921,204      | 08/02/2001  | Christopher S. Autterson | AAS104A             | 5914             |

7590

11/21/2003

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HARRISVILLE, MI 48740

EXAMINER

PICKETT, JOHN G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3728

DATE MAILED: 11/21/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/921,204

Applicant(s)

AUTTERSON, CHRISTOPHER S.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This Office Action acknowledges the applicant's Amendment C, presented as Paper No. 12. Claims 1 and 11 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 103***

3. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shackelford et al. (US 5,590,781).

Regarding claims 1 and 11, Shackelford et al. discloses in Figure 7 a shipping/packaging container body (200) having a first predetermined area (230) on an outer surface (Col. 7, ll. 12-18), first advertisement (240), and a second predetermined area (234) on an outer surface (Col. 7, ll. 12-18).

Shackelford et al. does not expressly disclose a first party owning said container, a second party or a second advertisement.

Stamps are a form of advertising of the United States Postal Service (USPS). Shackelford et al. teaches the use of stamps in second predetermined area (234), (col. 7, lines 12-18). The USPS is an entity of the federal government and is separate and distinct from private industry.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a first party manufacturing company own

shipping/packaging containers for use in the delivery of its products since such ownership is common and conventional in the packaging art.

It would further have been obvious to one of ordinary skill to ship a shipping/packaging container using the USPS as a second party, since such a delivery method is common and conventional in the shipping art. Using the USPS, it would have been obvious to one of ordinary skill in the art to place a second advertisement (stamp) onto container body (200) in second predetermined area (234) since such a placement is common and conventional in shipment through the USPS.

As to the second predetermined area being otherwise blank, the second advertisement (stamp) is placed on second predetermined area (234) for shipment, second predetermined area (234) would otherwise be blank if container body (200) were hand delivered by the first party (the manufacturing company), or if container body (200) were used for internal distribution.

As to the second predetermined area being allotted by the first party, second predetermined area (234) is allotted by the first party (the manufacturing company).

As to the second advertisement provided by the second party, second advertisement (stamp) is provided by the second party (USPS) to the first party (manufacturing company), and the first party (manufacturing company) determines second predetermined area (234).

As to party affiliations, the USPS is not affiliated in any way to manufacturing companies.

As to the size of the second advertisement, the size of the shipping/packaging container determines the number of stamps required for shipment. Therefore, the size of the shipping/packaging container determines, at least in part, the size (i.e. number) of the second advertisement (stamp).

4. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacGuire (US 2003/0141214 A1).

MacGuire discloses a shipping packaging container (2a-2d) with an outer and inner surface, a first advertisement (SOAP) provided by a first party (manufacturer) on a first predetermined area, a second advertisement (2a'-2d') provided by a second party (operating entity) on a second predetermined area, the second party is not affiliated in any way to the first party, and the first party determines the second predetermined area (see for example paragraph [0056]).

MacGuire meets all limitations claimed by the applicant except:

MacGuire lacks or does not expressly disclose that the second predetermined area would otherwise be blank or that the size of the second advertisement is determined, at least in part, by the shipping/packaging container size. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place the second advertisement on an area that would otherwise be blank in order to avoid covering important consumer information. It would have further been obvious to one of ordinary skill in the art at the time the invention was made to size the second

advertisement to fit the container. A one-foot square second advertisement would obviously be inappropriate for a two-inch cube container.

### ***Response to Arguments***

5. An advertisement is defined as the act or process of advertising. Therefore, when the examiner asserts that a stamp is a form of advertising, he is by definition, defining an advertisement.

6. The examiner contends that the applicant has already conceded that the stamp is an advertisement by the lack of argument in response to the first Office Action. However, in the interest of clarity, the examiner will respond to the applicant's arguments.


7. Based on the applicant's definition of an advertisement and the broad claim interpretation required by the MPEP, the answers to the applicant's hypothetical questions are not necessarily negative. However, the hypothetical questions are irrelevant to the case at hand. The relevant question is whether the stamp is an advertisement as defined by the applicant. The answer is yes. The examiner specifically points to the Elvis stamp issued January 8, 1993. The Elvis stamp is a publication, which calls public attention by emphasizing desirable qualities so as to arouse a desire to buy or patronize. The examiner interprets the artwork to be a desirable quality.


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
Gregory Pickett  
Examiner  
November 14, 2003

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700